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KENTON L. FREUDENBERG P.O. BOX 841 DURANGO, CO 81302			CHAMBERS, MICHAEL S	
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### BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/878,860  
Filing Date: June 09, 2001  
Appellant(s): MOCKRY ET AL.

MAILED

OCT 23 2006

Technology Center 2100

Kenton Freudenberg

For Appellant

### EXAMINER'S ANSWER

This is in response to the appeal brief filed August 16, 2006 appealing from the Office action mailed February 16, 2006

#### **(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

#### **(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

Web page downloaded on 10/20/05, ProQuest-Producing SportChannel, 7/18/97, [www.proquest.umi.com](http://www.proquest.umi.com), 3 pages

Web page downloaded on 10/20/05, The Media Channel, 1998, [www.web.archive.org/mediachannel.com](http://www.web.archive.org/mediachannel.com), 6 pages

Web page downloaded on 10/20/05, ProQuest-Baseball Lite, 7/26/95, [www.proquest.umi.com](http://www.proquest.umi.com), 1 page

Web page downloaded on 10/20/05, ProQuest-Watching in Fast Forward, 5/5/2002, [www.proquest.umi.com](http://www.proquest.umi.com), 1 page

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 23-25, 28-30, 33-35 37-38 and 40 are rejected under 35 U.S.C. 103(a)  
as obvious over ProQuest-Producing Sports Channel (pages 1-3). ProQuest discloses

that the idea of an edited an entire baseball game provided to subscribers is old in the art, dating to at least 1997.

**Baseball Lite: All the hits without the fat Fast editing turns a game into a 1-hour SportsChannel show;**

Winter is the producer of "SportsChannel Light," an unprecedented venture by San Francisco-based cable TV station SportsChannel Pacific to condense an afternoon baseball game into one hour and televise it the same evening.

**Producing SportsChannel 'Light' Is Heavy Duty; [FINAL Edition]**  
SUSAN SLUSSER. San Francisco Chronicle. San Francisco, Calif.: Jul 18, 1997. pg. B.3

The highlight shows, which condense A's and Giants' games into just a half hour, are put together on the fly – while the actual game is still in progress. Or more harrowing, while the "Light" program is already rolling, Host Glen Kuiper and his crew are often editing the final segment of the show as the first segment is on the air.

The gist of the program is to give a real flavor of the game, with as much of the pertinent action as possible. Walks cut into the program's 22 minutes, and, well, aren't very exciting.

The method claimed would naturally be used during the production and showing of the condensed game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected an appropriate number of action shots recorded including substantially every pitch from a fist pitch to the last pitch together with other action occurring during a game in order to permit the edited video to be broadcast in an allotted time.

As to claim 24: See claim 23 rejection. The decisions to record each appearance at bat for every player, the final pitch thrown to each player and successful and unsuccessful attempts by the base runners are design choices based on editing decisions by the editor or the time available for broadcast. The specification provides no unexpected or surprising results in recording the action plays of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal

preferences and time available. The method claimed would naturally be used when the video was produced and played.

As to claim 25: ProQuest discloses a 22 minute edited baseball game (see claim 23 rejection). Although the instant invention calls for a 15 minute time, no criticality is seen in the duration of the edited recording. The duration of the edited recording is a matter of design choice. The specification provides no unexpected or surprising results in using an edited recording of 15 minutes. It would have been obvious to one of ordinary skill in the art to select an appropriate length of time for the video to run based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 28: The use of video tape machines is old in the art. ProQuest discloses the using of a video tape machine.

Despite the time crunch, the atmosphere is as light as the show's name during the six-person production process – the tape machines are named "Lucy" and "Ricky."

The method claimed would occur naturally when the edited video tape was played. It would have been obvious to one of ordinary skill in the art to have included the method of playing the video tape since this is one of the logical reasons for producing the video. The method claimed would naturally be used when the video was produced and played. There is no patentable novelty in broadcasting a video. The means for display is a matter of design choice. The specification provides no unanticipated or surprising results from the various means of display chosen.

As to claim 29: ProQuest discloses an edited recording with audio .

The process of editing nine innings of baseball, adding graphics, voice-overs, music and a host to recap the scoring did indeed seem daunting on the drawing board, but Winter and company had pulled off the first four "Light" broadcasts with only a few minor hitches. And they did so by staying true to SportsChannel's initial concept.

Since the recording is broadcast, the inclusion of audio would naturally occur. No criticality is seen in the audio containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claim 30: See claim 25 rejection. The specification provides no unanticipated or surprising results from the time limitation claimed, therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art to have selected any group of equivalent times based on the desired times for showing the edited video.

As to claim 33: See claim 28 rejection. The use of video tape machines is old in the art. ProQuest discloses the using of a video tape machine.

Despite the time crunch, the atmosphere is as light as the show's name during the six-person production process -- the tape machines are named "Lucy" and "Ricky."

As to claims 34,37 and 40: See claim 29 rejection. Since the recording is broadcast, the inclusion of audio would naturally occur. No criticality is seen in the audio containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claims 35 and 38: ProQuest discloses a subscription service (pg 2-paragraph 7).

Overall, baseball ratings have skyrocketed for SportsChannel since moving from premium cable to expanded basic at the start of June.

It is well known that cable TV offers basic and premium services for a monetary fee. The method of obtaining additional revenue would naturally occur when subscribers opted for the premium service over the basic service.

Claims 27, 32, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over ProQuest as applied above and further in view of MediaChannel. MediaChannel discloses it is old in the art to broadcast condensed sports videos over the internet (1998). It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the broadcasting method of MediaChannel in order to increase the number of people subscribing to the service.

#### **(10) Response to Argument**

The applicant has made the argument that the instant invention is not an edited baseball game but a new and novel way to view an entire baseball game in a shorter period of time. The basic question here is what one of ordinary skill in the art would be aware of and would the method claimed in the instant invention be obvious to one of ordinary skill in the art.

In the CAFC decision on Sovish , the court took some pains to note what one of ordinary skill in the art would be aware of.

Art Unit: 3711

**In re Sovish, Moisson, and Selleslags (CAFC 226 USPQ 771 July 26, 1985, 85-781) the court found the argument that the propriety of combining references was proper for one skilled in the art:**

This argument presumes stupidity rather than skill.

The decision of the board is affirmed

One of ordinary skill in the art at the time of the invention would understand that the ProQuest newspaper articles demonstrated that the idea of recording an entire baseball game and reducing the time to watch the game was being preformed at least as early as 1997, therefore this aspect of the method is not novel. Although ProQuest fails to clearly disclose what is edited out of/left in the condensed videotape, one of ordinary skill in the art can make several obvious assumptions.

If one looks at a typical baseball game, there are two types of plays that occur

- A) Those actions that move the game forward to its conclusion and subsequently result in changing players on the field i.e. hits, runs, errors, stolen bases and outs.
- B) Those actions that incrementally move the game forward without changing players on the field i.e. thrown balls and 1<sup>st</sup> and 2<sup>nd</sup> strikes.

The action in the game occurs within group A, not group B, since this is where there is a potential for the game to visibly advance. While the actions that occur in Group B, are important to the game, they remain static i.e. a ball is thrown by the pitcher and the batter either swings or does not swing at the ball. Essentially these actions are interchangeable with each other since they never result in changing the status of the players on the field.

It would have been obvious to one of ordinary skill in the game when editing the video to include the activities that were most important in deciding the game's outcome as well as the final key moment when the game is over. Therefore, the edited film would include all of Group A's actions and as much of Group B as the editor wished to include in order to fill the appropriate time frame of the show. This is not using hindsight reasoning as much as it is using common sense. One of ordinary skill in the art would have no reason to include those actions that were not important to the outcome of the game over those actions that were important to the outcome of the game. Common Sense would appear to indicate action segments would be included.

In addition, the examiner notes that there are 54 outs in a complete baseball game (9 innings\*3 outs/inning\*2 teams= 54 outs). The last play generating the out in a baseball game takes less than 10 seconds to complete. Since ProQuest discloses editing a baseball game to 22 minutes, it would have been obvious to edit the game with all of the actions type of plays as defined in Group A since these plays have a direct impact on the outcome of the game. These plays could easily be edited to fit into ProQuest's 22 minute baseball game video recording (54 outs \* 10 seconds = 540 seconds/60 seconds = 9.0 minutes).

To recap the facts of the case for obviousness of the instant method:

- 1) Editing a major league baseball game video and playing it to a subscriber base is not novel. ProQuest was doing this at least as far back as 1997.
- 2) Although not clearly disclosed by ProQuest, it would have been obvious to one of ordinary skill in the art to include those parts of the game that were most important in

deciding the outcome of the game in order to increase viewer satisfaction by giving the viewer a full and complete essence of what happened in the game. These active parts would include the final pitch thrown to every batter and any successful/unsuccessful attempts of runners on base.

These activities are detailed in independent claims 23 and 24.

With regards to claims 25, and 30: The specification provides no surprising or unanticipated results from selecting a 15 minute time frame. In looking at the cable TV program make-up, the broadcast segments are made up along hour/half hour/ and quarter hour segments. Therefore it would have been obvious to one of ordinary skill in the art to have selected any one of several time frames in order to better accommodate the medium the show was broadcasting in. For example, a 32 minute show length would not be acceptable to a broadcast network since it deviates from its 30 minute window.

With regards to claims 35 and 38: The collection of revenue by a cable TV station via subscriptions is well known.

Overall, baseball ratings have skyrocketed for SportsChannel since moving from premium cable to expanded basic at the start of June.

There would naturally be a charge for a premium channel, thus the "method of obtaining revenue" in the limitation has been met.

With regards to claims 27,28,29,32,33,34,36,37,39, and 40: As noted above, these limitations are directed to well known activities of voice-overs and playing or broadcasting the edited tape. One of ordinary skill in the art would be aware of these

activities and would have utilized them in increasing the satisfaction of the subscribers to the condensed baseball game.

The applicant argued in paragraph 6 that the method in its simplest terms

The essence of that method, as described and claimed, is in its simplest terms, to show the last pitch to each batter. In other words, every batter is shown for every at "bat," but only one pitch to each batter is retained in the edited game, namely the last pitch to each such batter.

While the applicant's representative has taken pains to indicate that the instant invention is directed towards recording every batter but only the last pitch. Unfortunately this is in error. Had the claim language included the closed-ended term, consisting of: instead of the relatively open-ended term comprising essentially of: the statement would be correct. But the existing claim language is much broader than indicated by the applicant's representative. One could in theory consider all the other intermediate actions of the game to be non-essential items. In theory, this would mean that recording an entire baseball game with the essential final pitches and the non-essential non-final pitches would infringe the method claimed in the independent claims. As noted above and throughout the record of this application, the applicant is merely editing a sports game by utilizing the editorial control of one editing the tape which is well known in the art.

With regards to the argument that MLB has successfully utilized this method and therefore this commercial success should be an indication of patentability. The success or failure of an object utilizing a claimed method in the marketplace is a secondary consideration. The examiner does not know whether or not MLB is utilizing the method claimed in the instant invention. If the theory proposed by the applicant is carried to its logical endpoint, any instant invention having commercial success should be issued a

patent. Back in 1964, Ford had commercial success with its introduction of the Mustang car. By the applicant representative's logic, Ford should have been issued a broad patent on automobiles, even though the patentability of the automobile had long since passed to the public domain. In a similar vein, the editing and showing of a edited baseball game is old in the art.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Michael Chambers

Conferees



Eugene Kim



Vishu Mendiratta

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